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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/557,748

11/18/2005

Philippe Moser

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COGNIS CORPORATION
PATENT DEPARTMENT
300 BROOKSIDE AVENUE
AMBLER, PA 19002

EXAMINER

MI, QIUWEN

ART UNIT

PAPER NUMBER

1655

MAIL DATE

DELIVERY MODE

09/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/557,748	Applicant(s) MOSER ET AL.	
	Examiner Qiuwen Mi	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/18/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 11-16 in the reply filed on 8/3/07 is acknowledged.

Applicant argues that Groups I-VI relate to a single, general inventive concept under PCT Rule 13.1 and 13.2. The is not found persuasive. The inventions (in amended claims) listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, Richardson et al (Richardson et al, *Biochimica et Biophysica Acta* 872: 134-140, 1986) teach isolating eight iso-inhibitors of trypsin from seeds of *Adenanthera pavonina* (see Abstract). Richardson et al teach that the seeds were collected from trees, after removal of the testas (the thick and hard outer protective shell of a seed, see Wikipedia online) (thus hulled seed), the cotyledons were milled (20 mesh screen) and followed by extracting three or four times with 20 ml of acetone until the supernatant was colorless (defatting), followed protein extraction and separation of isoinhibitors (page 135, left column), therefore, there is no special technical feature in the application. Accordingly the groups are not so linked as to form a single general concept under PCT Rule 13.1., and therefore lack of unity of invention exists.

Claims 17-28 are withdrawn from further consideration as being drawn to nonelected inventions.

Claims Pending

Art Unit: 1655

Claims 1-10 are cancelled. Claims 11-28 are pending. Claims 17-28 are withdrawn.

Claims 11-16 are examined on the merits.

Claim Rejection 112, 1st

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are drawn to a cosmetic and dermatological preparation containing a defatted extract or seeds and/or an extract of defatted seeds of plants of the genus *Adenanthera*.

To provide adequate written description and evidence of possession of a claimed invention, the specification must provide sufficient distinguishing identifying characteristics of the invention. The factors to be considered include disclosure of complete or partial structure, physical and/or chemical properties, functional characteristics, structure/function correlation, methods of making the claimed product, or any combination thereof. In the instant case, the invention only provides the description of a species *Adenanthera pavonina*, and no description in

Art Unit: 1655

the specification regarding a representative number from the whole genus *Adenanthera* other than the species *Adenanthera pavonina*. Accordingly, in the absence of sufficient recitation of a representative number of the species of genus *Adenanthera*, the specification does not provide adequate written description of the claimed invention.

Vas-Cath Inc. v. Mahurkar, 19USPQ2d 1111, clearly states “applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the ‘written description’ inquiry, whatever is now claimed. The specification does not “clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is now is claimed.” (See Vas-Cath at page 1116). As discussed above, the skilled artisan cannot envision the detailed compound being claimed, and therefore conception is not achieved until reduction to practice has occurred, regardless of the complexity or simplicity of the compound. Adequate written description requires more than a mere statement of the total amount of the plant material being used. See *Fiers v. Revel*, 25USPQ2d 1601 at 1606 (CAFC 1993) and *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18USPQ2d 1016.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F. 2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the specification does “little more than outline [goals] appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.”) Accordingly, it is deemed that the specification fails to provide adequate written description for the claims and does not

Art Unit: 1655

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention.

Claim Rejections –35 USC § 112, 2nd

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 16 recite “with the proviso that the quantities shown add up to 100% by weight with water and optionally other auxiliaries and additives” and it is not clear what it means. Applicant is requested to change the wording of the sentence to make it clear.

Claim Rejections –35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1655

Claims 11-14 are rejected under 35 USC § 102 (b) as being anticipated by Richardson et al (Richardson et al, Biochimica et Biophysica Acta 872: 134-140, 1986).

Richardson et al teach isolating eight iso-inhibitors of trypsin from seeds of *Adenanthera pavonina* (see Abstract). Richardson et al teach that the seeds were collected from trees, after removal of the testas (the thick and hard outer protective shell of a seed, see Wikipedia online) (thus hulled seed), the cotyledons were milled (20 mesh screen) and followed by extracting three or four times with 20 ml of acetone until the supernatant was colorless (defatting), followed protein extraction and separation of isoinhibitors (page 135, left column).

The intended use of the composition was analyzed for patentable weight. It is deemed that the preamble 'breathes life' into the claims in that it is deemed that the prior art product must not be precluded for use as a cosmetic (topical) composition. It is deemed that the composition disclosed by Richardson et al. is not precluded for carrying out the intended function of the claims.

Therefore, the reference is deemed to anticipate the instant claim above.

Claim Rejections –35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2811226 in view of Richardson et al (Richardson et al, Biochimica et Biophysica Acta 872: 134-140, 1986).

FR 2811226 teaches a cosmetic composition for skin treatment, containing vegetable protein or vegetable extract with trypsin-inhibiting activity. FR 2811226 also teaches a process of cosmetic treatment of aging or dehydrated skin comprising topical application of sufficient quantity of vegetable trypsin inhibitor or plant extract containing such inhibitor (see Abstract, translation has been ordered).

FR 2811226 does not specifically teach the use of the extract of defatted, hulled *Adenanthera pavonina* seeds, or concentrations thereof as required by the claims.

Richardson et al teach isolating eight iso-inhibitors of trypsin from seeds of *Adenanthera pavonina* (see Abstract). Richardson et al teach that the seeds were collected from trees, after removal of the testas (the thick and hard outer protective shell of a seed, see Wikipedia online) (thus hulled seed), the cotyledons were milled (20 mesh screen) and followed by extracting three or four times with 20 ml of acetone until the supernatant was colorless (defatting), followed protein extraction and separation of isoinhibitors (page 135, left column).

Art Unit: 1655

It would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to apply the trypsin isoinhibitor extract from the defatted hulled *Adenanthera pavonina* seed from Richardson et al in the cosmetic of FR 2811226 since FR 2811226 teaches a cosmetic composition for skin treatment, containing vegetable protein or vegetable extract with trypsin-inhibiting activity (trypsin inhibitor and trypsin isoinhibitor have very similar activity, see http://www.ncbi.nlm.nih.gov/sites/entrez?cmd=Retrieve&db=pubmed&dopt=AbstractPlus&list_uids=7690595).

Since all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

Art Unit: 1655

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi

/Patricia Leith/
Patricia Leith
Primary Examiner
Art Unit 1655